

REMARKS

Claims 22 – 37, 55 and 59 - 80 are pending. The Examiner noted in the most recent Office Action that additional evidence on dates was required in the inventor's declaration for establishing diligence to overcome the main cited reference: O'Kane – US Publication No. 2003/0097299. Accordingly Applicant has obtained additional information for this declaration and submitted it herewith. Based on this new submission, and the applicable standards for establishing priority of invention, Applicants submit that the §102 rejections should be moot at this time.

The rejections under §112 are also addressed again, with a further explanation of why the claims are clearly definite within the requirements of the statute.

Reconsideration is thus requested.

Paragraph 4-5: Rejection of claims 22, 24, 25, 27, 35 and 37

The Examiner has withdrawn many of the rejections presented before for these claims, but has nonetheless rejected these claims based on the recitation of the phrase "and/or" - indicating that it is not clear what is included in this language. This rejection is traversed on the following basis.

First, there is no blanket prohibition against this type of language formulation. The MPEP section relied upon by the Examiner – 2173.05(d) involves so-called "exemplary" language, which is not what is at issue in this case.

Second, the PTO routinely considers and allows claims with this type of "and/or" language. For a sampling of such cases, please consider the claims in the following cases also prosecuted by the undersigned in different fields: 7,389,243 (e-commerce); 7,339,819 (spin memories); 7,277,854 (speech recognition); 7,138,329 (integrated circuit processing). Other examples could be provided if necessary. Thus Applicant submits that the suggestion that the phrase is indefinite as a matter of law, regulation or procedure is simply not correct.

Third, the Examiner states that it is not clear whether "...the succeeding language is included, as part of the limitation or it is in the alternative.." Applicant submits that the term "and/or" is a well-known logical linguistic construct which means, in the general context of "A and/or B" that any of the following scenarios are covered: A

alone; B alone A and B together. This is just a basic dictionary definition, and the online wikipedia confirms this general understanding:

....And/or is a phrase used to indicate that one or more of the stated cases may occur. For example, the sentence "Jim will eat cake, pie, and/or brownies" indicates that although Jim may eat any of the three listed desserts, the choices are not necessarily exclusive; Jim may eat one, two, or all three of the choices.

See [h-t-t-p://en.wikipedia.org/wiki/And/or](http://en.wikipedia.org/wiki/And/or)

Note how this usage is completely consistent with the explanation given by the specification. The recitation in claim 22 is as follows:

....(c) a first software routine executing on said first computer **and/or** said second computer, said first software routine being adapted to coordinate transfer of said digital asset to said second computer;

The limitation merely states that the first software routine could be executing on either or both of the first and second computers. This routine is responsible for coordinating the transfer of the digital asset to the second computer, and could include different components. It would be apparent to one skilled in the art from such language that the routine does not need to reside in any particular physical location, a fact that the claim language expresses quite accurately and is supported in the specification. See e.g., page 21, ll. 5 – 11; “....For ease of use, the setup and transfer may be performed by *either or both of such devices...*” Consequently the Applicant respectfully submits that the claim as written is certainly definite within the statutory requirements.

The rejection is thus traversed, since the language makes clear that the claim covers embodiments in which: 1) the first software routine executes on the first computer; 2) the first software routine executes on the second computer; 3) the first software routine executes on both. Thus, there is nothing “indefinite” about the claim, as the language used is known to convey this basic understanding.

From a §112 perspective, the mere fact that the claim can be interpreted *broadly* in light of the specification does not render it in *indefinite*. The test for whether claims are sufficiently “definite” is whether one skilled in the art would be able to discern the scope of the claim “....when read in light of the specification.” Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). The specification makes clear which scenarios are covered by the claims. Accordingly Applicant submits that the language of the claim is not “indefinite” – it is merely broad enough to cover all of these approaches.

As the Examiner is also probably well aware, the Federal Circuit has repeatedly emphasized that:

The purpose of claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant. A claim is not "indefinite" simply because it is hard to understand when viewed without benefit of the specification. S3 Inc. v. Nvidia Corp., 259 F.3d 1364, 59 U.S.P.Q.2d 1745 (Fed. Cir. 2001).

The claim as worded is not hard to understand, and any ambiguity is clearly resolved by reference to the specification, which, as noted, gives the precise examples noted above. Consequently Applicants submit that the claims are well within the requirements of § 112.

Paragraphs 6 – 7 - Rejection of claims 22 - 37 and 55 in light of O'Kane

These claims were rejected under a single § 102(e) count, based on the O'Kane reference, US Publication No. 2003/0097299. This reference has an effective filing date of November 21, 2001 ("prior art date").

To overcome this reference the Applicants have re-submitted the declaration of one of the inventors, Mr. Bryan Dunkeld. As to the diligence issue¹, the newly presented declaration contains additional facts and specific dates to establish that the Applicants diligently reduced to practice (on December 10, 2001) beginning from at least a time immediately before such prior art date. To wit Mr. Dunkeld confirms that:

- The materials shown in the exhibits were part of a draft application that was undergoing regular revisions both prior to and after the prior art date (November 21 2001). The materials were then embodied in the patent filing made on December 10, 2001 - less than 3 weeks after the filing date of the reference. See Declaration, ¶ 7.
- The Exhibit 1 materials were contained in a Microsoft WORD document provided to Mr. Gross at least as early as November 2, 2001 for the latter to prepare as a formal application. See Exhibit 5 and Declaration, ¶ 8.
- In between November 2, 2001 and the actual filing date (December 10, 2001) the case was in the undersigned's hands, as he actively prepared the formal application. Another draft of the specification was exchanged on November 19, 2001 – see Exhibit 6. See Declaration, ¶ 10

¹ The Examiner has not raised any questions as to the adequacy of the conception materials.

- After delivering such second draft, the disclosure underwent further active and regular treatment to put it into appropriate form for filing. The inventors communicated regularly with the undersigned between November 19 and December 10 (the filing date) to assist him, discuss changes to the disclosure, and ensure that the filing would be made on a timely basis. As seen in Exhibit 7, in this email the undersigned confirmed that was going to finalize the application during sometime during the week of December 4, and the inventors made arrangements to sign and return the appropriate oaths and powers of attorneys. See Declaration, ¶ 10.
- The inventor notes that the undersigned was working on such application as expeditiously as possible given his other backlog of cases at such time. In fact, the undersigned adjusted his schedule to advance and perfect the application over other projects he had at such time. The inventor further understands that it is typical that most patent attorneys will require several weeks if not months of time to convert a disclosure into a formal filing, yet the undersigned did it in just a few weeks to handle our case. Thus in addition to the inventor's efforts the undersigned was also working extremely diligently on the inventor's behalf to reduce the inventions to practice in the form of the present filing. See Declaration, ¶ 11.

Supporting/corroborating materials are also provided in Mr. Dunkeld's declaration to satisfy the requirements of 37 C.F.R. 1.132. Given this information, and given no other substantive rejections are presented in the present record, Applicant submits that the claims should be passed on for allowance.²

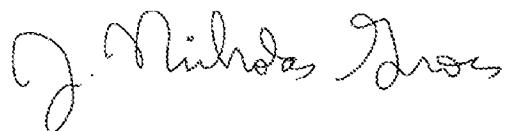
Conclusion

The rejections and objections from the Examiner have been addressed in detail as noted above. For the reasons set forth above, the undersigned submits that the claims should be confirmed as patentable over the references.

² The present response is presented without waiver or prejudice to present additional arguments over the prior art should it become necessary to do so. However as such appears unnecessary at this time Applicant believes it is unproductive to present such additional arguments.

Should the Examiner wish to discuss the present case at any time, please contact the undersigned at any convenient opportunity.

Respectfully submitted,



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